



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,763	06/26/2000	Tsuyoshi Katayama	2185-0452P-SP	3604

7590 01/09/2003

Birch Stewart Kolasch & Birch LLP
P O Box 747
Falls Church, VA 22040-0747

EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
----------	--------------

1617

DATE MAILED: 01/09/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/604,763

Applicant(s)

KATAYAMA ET AL.

Examiner

Lauren Q Wells

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-29 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-29 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1617

DETAILED ACTION

Claims 17-29 and 33 are pending. The Amendment filed 9/18/02, cancelled claims 30-32, amended claims 18, 20, and 29, and added claim 33.

Request for Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/18/02 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claim 17 is vague and indefinite, as it is confusing. The claim recites a percent weight without any means of comparison. Is it the percent weight of the external agent as a whole? Is it the percent weight of a monocarboxylic acid? A dicarboxylic acid? something else?

(ii) Claim 33 is vague and indefinite, as it is confusing. Is Applicant claiming a range within a range? Does the 2nd Markush group, beginning on line 7, refer to cyclic acids? Is the dimerdiol ester of a dicarboxylic acid part of the second Markush group? It is not clear how the different parts of the claim relate to each other.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-20, 22-29, and 33 rejected under 35 U.S.C. 103(a) as being unpatentable over Ansmann et al. (5,795,978) in view of Akrongold (3,846,550).

The instant invention is directed to a cosmetic comprising a dimerdiol ester of a monocarboxylic acid having 10-32 carbon atoms and/or a dimerdiol ester of a dicarboxylic acid.

Ansmann et al. teach emulsifiers particularly suitable for the production of storable, high viscosity and sensorially light oil-in-water emulsions which are for use in cosmetic and/or pharmaceutical formulations. Suitable oils for said emulsions include esters of linear and/or branched fatty acids with polyhydric alcohols, for example dimmer diol or trimer diol, and/or Guebert alcohols. Suitable oils are disclosed as comprising 5-99% of the non-aqueous components of the emulsions. Exemplified are oil-in-water creams with vitamin E. The reference fails to teach the number of carbon atoms the fatty acids comprise. See abstract; Col. 1, lines 10-15; Col. 4, lines 39-56.

Akrongold et al. teach a cosmetic skin powder containing urea, an oil phase and an inorganic pigment. Oils that may be used in the powder include acids and alcohols which may be saturated or unsaturated, straight or branched and comprising 5-52 carbons. Acids included for said oils are oleic, stearic, isostearic and dimer acids, and esters thereof. See abstract; Col. 1, lines 24-60.

Art Unit: 1617

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Akrongold into the invention of Ansmann to obtain carboxylic acids or monocarboxylic acids of fatty acids having 4-34 carbon atoms because a) both references teaches esters of fatty acids as oils for use in skin care compositions; b) Ansmann teaches other fatty acid ester oils as comprising 6-20 carbon atoms; thus, given that Ansmann teaches other fatty acids ester oils as comprising 6-20 carbon atoms and given that Akrongold teaches that fatty acid esters can comprise 5-52 carbon atoms, one of skill in the art would have been motivated to teach the "esters of linear and/or branched fatty acids with polyhydric alcohols (for example dimer diol" of Ansmann, as comprising 5-52 carbon atoms.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ansmann et al. in view of Akrongold as applied to claims 17-20, 22-29, and 33 above, and further in view of Bernhardt et al. (4,788,054).

Ansmann and Akrongold are applied as discussed above. The references lack rosin.

Bernhardt et al. teach coating compositions comprising cosmetic emulsifiers and thickeners or viscosity modifiers. Suitable thickeners include ester gums which are semi-synthetic reaction products of rosin and a polyhydric alcohol. See abstract; Col. 8, line 38-Col. 9, line 16.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bernhardt into the invention of the combined references and obtain monocarboxylic acids comprising rosin or hydrogenated rosin because a) the combined references and Bernhardt all teach cosmetic emulsions comprising fatty acid esters as cosmetic oils; b) Bernhardt teaches that rosin esters increase the viscosity of emulsions,

Art Unit: 1617

thereby thickening them; thus, since the combined references teach their emulsions in the forms of creams and lotions, one of skill in the art would be motivated to teach the fatty acids of the combined references as rosin because of the expectation of thickening their products.

Notes

Regarding claim 25, the Examiner respectfully points out that the patentability of a product-by-process claim is dependent on the product itself and not on its method of production.

In re Thorpe.

Response to Arguments

Applicant argues, "Ansmann '978 does not disclose a dimer acid". While this is correct, the Examiner respectfully points out that the rejection was made in combination with Akrongold, who does teach a dimer acid.

Applicant argues, "Ansmann '978 discloses an emulsifier that is a mixture of alkyl and/or alkenyl oligoglycoside and fatty alcohols. The emulsifier is not a fatty acid ester and has no relation to a dimerdiol ester". This argument is not persuasive, as the Examiner is not relying upon this specific teaching in Ansmann '978 to teach dimerdiol esters. See Col. 4 of Ansmann for teachings of dimerdiol esters.

Applicant argues, "one of ordinary skill in the art would not be motivated to replace the alcohol moieties of the esters of fatty acids disclosed in Akrongold at column 1, lines 56-61 with dimerdiol to arrive at a cosmetic composition". This argument is not persuasive. See the above 103 rejection for motivation to combine the two references.

Applicant argues, "the cosmetic composition of Ansmann is completely different from the cosmetic of Akrongold. The number of carbon atoms is different in the different

Art Unit: 1617

compositions. As such, one of ordinary skill in the art would not be motivated to combine the references". This argument is not persuasive. The Examiner respectfully points out that both Ansmann and Akrongold are directed to cosmetic compositions for application to the skin, comprising fatty acid esters as oils. Thus, these references are related.

Applicant argues, "It appears however, that dimer diol as used in Ansmann is represented by the formula HO-Ar-O-Ar-O-Ar-H. . .however, this is not the dimerdiol of the present invention". This argument is not persuasive. The Examiner respectfully points out that Applicant's claims are not limited to a specific form of a dimer diol, but that the claims generally recited "dimer diol". Thus, the dimer diol taught by Ansmann meets the limitation of a dimer diol in the instant claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

Application/Control Number: 09/604,763

Page 7

Art Unit: 1617

lqw

November 19, 2002



SREENI PADMANABHAN
PRIMARY EXAMINER

11/24/02